

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

512100-2047

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Application Number

10/534,797

Filed

05/12/2005

First Named Inventor

ROREGER et al.

Art Unit

3752

Examiner

HWU, Davis D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 48,104

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202-292-1539

Telephone number

20 January 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Status of claims

Claims 1, 4-14 and 18-24 are pending in this application. An after final response was filed on 18 December 2009 which has been entered. The applicants request reconsideration of the 35 U.S.C. 103(a) rejection made in the final rejection of 20 October 2009.

Paragraph numbers [] referred to in the reasons below correspond to U.S. Patent Application Publication No. 2006-0016905, i.e. the publication of this application.

II. Basis for clear error in 35 U.S.C. 103 rejection ("new matter")

Claims 1, 4-14 and 18-24 were rejected as allegedly being obvious over Paul (U.S. Patent 5,556,030). However, the rejection relies on some factual interpretations which are incorrect.

1. The dispenser of Paul does not serve to control the release of the volatile substance with two control elements. Part of the confusion may stem from the different views of the Paul dispenser.

Figure 7 shows element 58 (a fragrance bearing member which comprises a solid construction or a gel securely retained between permeable membrane layers 50 and 55 – see col. 13, lines 32-34). The permeable membrane layers can be interpreted as correlating to the first control element of the applicants' invention (additional difference explained in section 2. below).

However, side wall or panels 22 and 23 in Paul are not control elements, but rather packaging for the dispenser. The packing is torn open to expose the permeable membrane layers 50 and 55 to the atmosphere, i.e. the volatile substance passes through only one layer, not two.

The holes 33-36 and the elongated sealing strip 38 are part of the embodiment of Figure 2 which differs from Figure 7. Element 30 is the fragrance bearing member (akin to element 58) wherein the fragrance diffuses into the a holding zone or pouch 24. The holes 33-36 are over this holding zone and not the permeable membrane layer 50 or 55, i.e. the structure of Figure 2 also does not have two control elements working in concert as in the applicants' claimed dispenser.

2. The statement in the Office Action that the Paul dispenser comprises a reservoir "wherein in first control element is a pressure-sensitively adhesive" (Page 2, second and third lines from

bottom) is not found in Paul. The "first control element 50" is a permeable membrane layer. See col. 11, lines 23-31 of Paul:

"By constructing permeable membrane 50 in the manner consistent with the molecular structure of the air freshening/deodorizing composition being employed, the rate of dispersion of the air freshening/deodorizing composition into the ambient air is precisely controlled automatically. Furthermore, the use of permeable membrane 50 assures a continuous, dependable and completely repeatable rate of dispersion of the air freshening/deodorizing composition into the ambient surroundings."

See also col. 13, lines 47-59

"Furthermore, permeable membrane layers 50 and 55 may be formed from any suitable material capable of providing a layer compatible with side walls or panels 22 and 23, *as well as incorporating a pore size consistent with the molecular structure of the fragrance to be dispersed therethrough*. Preferably, permeable membrane layers 50 and 55 are formed from polymeric plastic films or sheets which are impermeable to liquids but allow vapors to pass therethrough. Generally, any suitable polymeric film or sheet can be employed, such as sheets or films formed from polyurethane, polyethers, polyesters, polypropylenes, polystyrene, and combinations thereof." (emphasis added)

There is no disclosure in Paul that these control elements 50 or 55 are a pressure-sensitive adhesive.

In addition to the fact that Paul does not have two control elements, it also follows that Paul's first control element is not adhesively attached to the second control element as in the applicants' claimed invention as Paul's first control element is not comprised of a pressure-sensitive adhesive.

3. The number of gaps in the second control element is not simply a matter of design choice as asserted in the Office Action, but is essential for determination of the degree of coverage of the first control element and thereby controlling the predetermined release rate of the volatile substance.

4. The statement in the Advisory Action in paragraph 11. that "...an adhesive is any substance that will attach to a surface, element 55 attaches to a surface thus making it a pressure sensitive adhesive" is also factually incorrect. A dictionary definition for an adhesive is that it is "[a]ny substance, inorganic or organic, natural or synthetic, that is capable of *bonding other substances* by surface attachment." (see Hawley's Condensed Chemical Dictionary (15th Edition), ed. Richard J. Lewis, page 25, (2007)). Paul does not describe this function for element

55 nor is it an inherent function as there is no bonding of other substances much less a teaching that the bonding is pressure sensitive.

Likewise, one of ordinary skill in the art giving the applicants' claims its broadest reasonable interpretation consistent with the specification would not read the scope of the claim as encompassing element 55 as described by Paul.